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FOLEY & LARDNER LLP P.O. BOX 80278 SAN DIEGO, CA 92138-0278			TAYLOR, BARRY W	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/767,451	Applicant(s) FRY, GEORGE
	Examiner Barry W. Taylor	Art Unit 2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 November 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 21-34,36-53 and 55-59 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 34,36,37,53,55 and 56 is/are allowed.
- 6) Claim(s) 21,22,24-32,38-42,44-51 and 57-59 is/are rejected.
- 7) Claim(s) 23,33,43 and 52 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 July 2007 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-646)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 21-22, 25, 27-28, 32, 38-42, 45, 47, 51, and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heatley (7,142,895) in view of Kim (6,882,860).

Regarding claim 41. Heatley teaches an apparatus for effectuating a data service in a communication system, said apparatus comprising:

a delivery mode determiner configured to associate a service delivery mode with said data service based on a request for effectuation of said data service with an intended receiving station (see figure 2 wherein Network Switching Subsystem 36 is used to determine delivery mode (i.e. item 70 figure 3) which is associated with a data service such as Short Message (item 72-1 figure 3) or email (item 72-3 figure 3) or FAX (item 72-4 figure 3)); and

a call delivery director, configured to conduct call set-up procedures and route said data service to a terminating endpoint based on said service delivery mode (see col. 7 line 14 – col. 9 line 43, figure 2 wherein Network Switching Subsystem 36 is used to conduct call set-up procedures and route SMS, email or FAX to a called terminal based on the service delivery mode (i.e. item 70 figure 3)).

According to Applicants, Heatley does not teach an indication of the service delivery mode within a request (see Applicants amendments and remarks, paper dated 7/2/2007).

Kim teaches using an indication of service delivery in a call request so the receiving party can distinguish between different types of incoming data service calls (abstract, col. 1 lines 14-30) either by ear or sight (col. 6 lines 43-51). Kim discloses incoming data service call alerts and displays can be set by either the manufacture or user (col. 4 line 15 – col. 6 line 42).

It would have been obvious for any one of ordinary skill in the art at the time of invention to incorporate the teachings of Kim into the teachings of Heatley in order to allow users to distinguish between incoming call service types.

Regarding claim 42. Heatley teaches the apparatus wherein said terminating endpoint is selected from the group consisting of: a intended receiving station, a terminating station, and a store and forward location (see figure 3 wherein service such as SMS, email, FAX is routed to a called mobile phone (which reads on receiving station or terminating station) and diverted to Voice Mail (which reads on store and forward location)).

Regarding claim 45. Heatley does not explicitly show the request includes an indication of said service delivery mode, and wherein said delivery mode determiner is further configured to employ said indication to associate said service delivery mode with said data service.

Kim teaches using an indication of service delivery in a call request so the receiving party can distinguish between different types of incoming data service calls (abstract, col. 1 lines 14-30) either by ear or sight (col. 6 lines 43-51). Kim discloses incoming data service call alerts and displays can be set by either the manufacture or user (col. 4 line 15 – col. 6 line 42).

It would have been obvious for any one of ordinary skill in the art at the time of invention to incorporate the teachings of Kim into the teachings of Heatley in order to allow users to distinguish between incoming call service types.

Regarding claim 47. Heatley teaches a database comprising a plurality of database entries, each of said database entries contains a receiving station identifier (col. 7 lines 5-64) and associated service interaction indicia; a service interaction indicia determiner configured to determine service interaction indicia values from said associated service interaction indicia obtained from said database based on an identity of said intended receiving station (see figure 4 wherein different interaction indicia are shown (i.e. divert to VM, send SMS, send FAX, send email); and wherein said call delivery director is further configured to route said data service based on said service interaction indicia (see figure 4 wherein if the service interaction indicia value is divert to VM then call is diverted to VM).

Method claims 21-22, 25 and 28 are rejected for the same reasons as apparatus claims 41-42, 45 and 47 since the recited apparatus would perform the claimed method steps.

Regarding claim 27. Heatley teaches wherein said associating includes determining said service delivery mode based on said intended receiving station or said originating station (col. 7 line 5 – col. 8 line 67, col. 9 lines 4-43).

Regarding claim 51. Heatley teaches an apparatus to originate a data service in a communication system, said apparatus comprising: a processor configured to generate a data service request, wherein said data service request includes an indication of a service delivery mode associated with said data service; and a transmitter configured to transmit said data service request (col. 5 lines 8-11).

According to Applicants, Heatley does not teach an indication of the service delivery mode within a request (see Applicants remarks, paper dated 7/2/2007).

Kim teaches using an indication of service delivery in a call request so the receiving party can distinguish between different types of incoming data service calls (abstract, col. 1 lines 14-30) either by ear or sight (col. 6 lines 43-51). Kim discloses incoming data service call alerts and displays can be set by either the manufacture or user (col. 4 line 15 – col. 6 line 42).

It would have been obvious for any one of ordinary skill in the art at the time of invention to incorporate the teachings of Kim into the teachings of Heatley in order to allow users to distinguish between incoming call service types.

Method claim 32 is rejected for the same reason as apparatus claim 51 since the recited apparatus would perform the claimed method steps.

Regarding claim 57. Heatley teaches a data service apparatus in a communication system, said apparatus comprising:

a receiver configured to receive an indication of a delivery of a data service, wherein said indication includes a service delivery mode (see figure 3 item 70); and a user-interface configured to alert a user of said apparatus upon receipt of said indication, and wherein said user-interface is further configured to receive a response to said alert from said user (col. 5 line 8 – col. 6 line 32).

Heatley further teaches the service deliver mode being one of a foreground service delivery mode or a background service delivery mode (see col. 9 lines 4-58 wherein the caller selects from two or more delivery modes. In other words, Heatley offers callers two or more modes of delivery (col. 9 lines 30-58)).

According to Applicants, Heatley does not teach an indication of the service delivery mode within a request (see Applicants amendments and remarks, paper dated 7/2/2007).

Kim teaches using an indication of service delivery in a call request so the receiving party can distinguish between different types of incoming data service calls (abstract, col. 1 lines 14-30) either by ear or sight (col. 6 lines 43-51). Kim discloses incoming data service call alerts and displays can be set by either the manufacture or user (col. 4 line 15 – col. 6 line 42).

It would have been obvious for any one of ordinary skill in the art at the time of invention to incorporate the teachings of Kim into the teachings of Heatley in order to allow users to distinguish between incoming call service types.

Regarding claim 58. Heatley teaches a transmitter configured to transmit said response to said communications system (col. 5 lines 8-10). Kim also teaches sending response to communications system when user presses a key or automatically (col. 6 lines 38-42).

Regarding claim 59. Heatley teaches a transmitter configured to transmit an indication of said response to said communications system (col. 5 lines 8-10). Kim also teaches sending response to communications system when user presses a key or automatically (col. 6 lines 38-42).

Method claims 38-40 are rejected for the same reason as apparatus claims 57-59 since the recited apparatus would perform the claimed method steps.

2. Claims 30-31 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heatley (7,142,895) in view of Kim (6,882,860) further in view of Goto et al (6,044,278 hereinafter Goto).

Regarding claims 30 and 49. Heatley in view of Kim do not explicitly show generating an acceptance request to the receiving station. However, Heatley discloses call forwarding, divert to another phone or voicemail, screening, etc., which clearly requires acceptance at the called party side.

Goto also teaches indicating a service delivery mode when originating station request a data service call to a called terminal thereby enabling the called terminal two switch between different receive modes (col. 1 lines 5-15). Goto also teaches generating an acceptance request so the calling station can be sure that the message

was properly transmitted to the receive side (col. 1 lines 44-62, col. 2 lines 32-57, col. 3 lines 45-51, col. 7 lines 9-44).

It would have been obvious for any one of ordinary skill in the art at the time of invention to modify the teachings of Healey and Kim to include an autoresponse command as taught by Goto in order to allow called station the ability to switch between different modes of communication and indicating back to the calling station the status of the called terminal (i.e. busy, transmission complete or transmission failed).

Regarding claims 31 and 50. Heatley teaches wherein said terminating endpoint is said intended receiving station if said response indicates acceptance of said data service (see col. 7 lines 48-52 wherein calls may be forwarded to mobile telephone).

3. Claims 24, 26, 29, 44, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heatley (7,142,895) in view of Kim (6,882,860) further in view of Glitho et al (6,687,356 hereinafter Glitho).

Regarding claims 24 and 44. Heatley in view of Kim do not show wherein said terminating endpoint is said intended receiving station if said service delivery mode is a background service delivery mode, a diagnostic service delivery mode, or a maintenance service delivery mode. Heatley teaches foreground services which is user specific but is silent with respect to device specific mode (i.e. background, diagnostic or maintenance).

Glitho also teaches a user profile used to store delivery modes, which are both device and user specific (title, abstract, col. 2 lines 8-67). Glitho teaches user specific

profile (i.e. foreground service) used to designate a time period during which Call Forward Unconditional service is to be provisioned (col. 4 line 29 – col. 5 line 44, figure 4) and device specific profile (i.e. background service) used to specify policies to be used for specific devices (col. 4 line 29 – col. 5 line 44, figure 4). For example, John Doe has an office phone having defined service policies that invokes Call Forward No Answer or Call Forward Busy when John Doe is not available such that calls are diverted to his mobile phone.

It would have been obvious for anyone of ordinary skill in the art at the time of invention to modify the user profile as taught by Heatley in view of Kim to include device specific profile as taught by Glitho thereby providing a more flexible system that allows calls directed to specific devices to be diverted to another device based on the service policy of the device.

Regarding claims 26 and 46. Heatley in view of Kim do not show: a database comprising a plurality of database entries, each of said database entries contains an originating station identifier and an associated service delivery mode; and said delivery mode determiner is further configured to obtain said associated service delivery mode from said database based on an identity of said originating station and employ said associated service delivery mode as said service delivery mode.

Glitho also teaches a user profile used to store delivery modes, which are both device and user specific (title, abstract, col. 2 lines 8-67). Glitho teaches user specific profile (i.e. foreground service) used to designate a time period during which Call Forward Unconditional service is to be provisioned (col. 4 line 29 – col. 5 line 44, figure

4) and device specific profile (i.e. background service) used to specify policies to be used for specific devices (col. 4 line 29 – col. 5 line 44, figure 4). For example, John Doe has an office phone having defined service policies that invokes Call Forward No Answer or Call Forward Busy when John Doe is not available such that calls are diverted to his mobile phone.

It would have been obvious for anyone of ordinary skill in the art at the time of invention to modify the user profile as taught by Heatley in view of Kim to include device specific profile as taught by Glitho thereby providing a more flexible system that allows calls directed to specific devices to be diverted to another device based on the service policy of the device.

Regarding claims 29 and 48. Heatley in view of Kim do not show service interaction indicia are selected from the group consisting of: a call-forwarding-busy, a call-forwarding-default, a call-forwarding-no answer, a call-forwarding-unconditional, and a do-not-disturb.

Glitho also teaches a user profile used to store delivery modes, which are both device and user specific (title, abstract, col. 2 lines 8-67). Glitho teaches user specific profile (i.e. foreground service) used to designate a time period during which Call Forward Unconditional service is to be provisioned (col. 4 line 29 – col. 5 line 44, figure 4) and device specific profile (i.e. background service) used to specify policies to be used for specific devices (col. 4 line 29 – col. 5 line 44, figure 4). For example, John Doe has an office phone having defined service policies that invokes Call Forward No

Answer or Call Forward Busy when John Doe is not available such that calls are diverted to his mobile phone.

It would have been obvious for anyone of ordinary skill in the art at the time of invention to modify the user profile as taught by Heatley in view of Kim to include device specific profile as taught by Glitho thereby providing a more flexible system that allows calls directed to specific devices to be diverted to another device based on the service policy of the device.

Allowable Subject Matter

4. Claims 34, 36, 37, 53, 55 and 56 are allowed.
5. Claims 23, 33, 43 and 52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

6. Applicant's arguments filed 11/11/2008 have been fully considered but they are not persuasive.

- a) Applicants never address the Goto et al (6,044,278) reference (see paper dated 11/11/2008)?

The Examiner notes that Goto teaches indicating a service delivery mode when originating station request a data service call to a called terminal thereby enabling the called terminal two switch between different receive modes (col. 1 lines 5-15). Goto also teaches generating an acceptance request so the calling station

can be sure that the message was properly transmitted to the receive side (**col. 1 lines 44-62, col. 2 lines 32-57, col. 3 lines 45-51, col. 7 lines 9-44**).

b) Applicants argue that independent claim 57 has been amended with the same limitations as indicated as being allowable (see bottom of page 9, paper dated 11/11/2008).

The Examiner disagrees. Applicants amendment to independent claim 57 is actually a broader version of the indicated allowable subject matter.

c) Applicants argue that a notation of whether a particular call is voice call, a circuit call, etc. is not the same as identifying service deliver modes (see bottom of page 10, paper dated 11/11/2008).

The Examiner notes that Heatley offers the caller two or more modes of delivery (col. 9 lines 30-58). For example, an announcement "For delivery by SMS, key or speak one. For delivery by voicemail, key or speak two is provided to the calling party. Therefore, the delivery mode would be SMS or voicemail which clearly reads on Applicants claim language.

d) Applicants argue (see bottom of page 10, paper dated 11/11/2008) that a "service delivery mode" refers to the manner in which a particular service is to be delivered to a terminating endpoint. For example, and as noted in the present specification, a **background delivery mode refers to the fact that the delivery of the data service at issue is effectuable regardless of the availability of a receiving party to accept delivery of the data service**. On the other hand, a **foreground delivery service mode refers to the fact that the particular data call at issue**

maybe more user-specific, thereby raising the possibility that the call will need to be routed differently if the user is not currently available. In other words, a service delivery mode is a type of descriptor of how a particular data service is to be delivered to the receiving station.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a **background delivery mode refers to the fact that the delivery of the data service at issue is effectuable regardless of the availability of a receiving party to accept delivery of the data service**. On the other hand, a **foreground delivery service mode refers to the fact that the particular data call at issue maybe more user-specific, thereby raising the possibility that the call will need to be routed differently if the user is not currently available. In other words, a service delivery mode is a type of descriptor of how a particular data service is to be delivered to the receiving station.**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

e) Applicants argue that Kim does not teach both "background delivery" and "foreground delivery" (see page 11, paper dated 11/11/2008).

The Examiner is not sure which claims Applicants are referring to? The Examiner notes that "some" the independent claims are extremely vague with regards to background and/or foreground. It appears that Applicants are arguing the already indicated allowable subject matter.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry W. Taylor, telephone number (571) 272-7509, who is available Monday-Thursday, 6:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached at (571) 272-7023. The central facsimile phone number for this group is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 2600 receptionist whose telephone number is (571) 272-2600, the 2600 Customer Service telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Centralized Delivery Policy: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph

Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the central fax number (571-273-8300).

*/Barry W Taylor/
Primary Examiner, Art Unit 2617*